

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: George H. BuAbbud
Serial No.: 09/932,867
Filing Date: August 17, 2001
Examiner: Hai V. Tran
Group Art Unit: 2623
Confirmation No.: 6937
Title: RF RETURN OPTICAL TRANSMISSION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

REQUEST FOR PRE-APPEAL BRIEF REVIEW

In response to the Advisory Action mailed April 6, 2006, Applicant respectfully requests a Pre-Appeal Brief review of this Application so that the rejection of the claims and the objections to the Application can be reconsidered prior to submission of an Appeal Brief.

REMARKS

This Request for Pre-Appeal Brief Review is being filed in accordance with the provisions set forth in the Official Gazette Notices of July 12, 2005 and January 10, 2006. Pursuant to the Official Gazette Notices, this Request for Pre-Appeal Brief Review is being filed concurrently with a Notice of Appeal. Applicant respectfully requests reconsideration of the Application in light of the remarks set forth below.

Claims 1-5 currently stand rejected under 35 U.S.C. §103(a) as being unpatentable over Beveridge in view of Feldman, et al. Claim 7 currently stands rejected under 35 U.S.C. §103(a) as being unpatentable over Beveridge in view of Feldman, et al. and further in view of Kitazawa, et al. In the prosecution of the present Application, the Examiner's rejections and assertions contain clear errors of law, including a failure to establish a prima facie case of obviousness. To assist the Panel in the review of this Request for Pre-Appeal Brief Review, Applicant submits the following brief summary for consideration.

In the Advisory Action of April 6, 2006 and the Final Action of December 29, 2006, the Examiner indicates that the Feldman, et al. patent discloses a downstream wavelength of 1.5 μm on the optical fiber being a combination of multiple wavelengths. However, individual local headend wavelengths are separated and each inserted into a different branch of the network. See col. 7, lines 20-24, of the Feldman, et al. patent. Thus, each local headend wavelength is transmitted over its own 1.5 μm optical fiber path. Thus, the Feldman, et al. patent only discloses 1.5 μm wavelength over an optical fiber from a first end to a second end and a 1.3 μm wavelength over the optical fiber from the second end to the first end. Only one wavelength is used in each transport direction over the optical fiber of the Feldman, et al. patent.

In addition, the Examiner further asserts that Applicant's argument of the Feldman, et al. patent failing to disclose transmitting light at the first wavelength carrying a return plain old telephone service telephonic signals with TV related information is baseless because the claimed invention does not include this limitation. Applicant respectfully submits that the claimed invention does include this limitation virtually word for word as argued by Applicant in the Response to Examiner's Action. See Claim 1 and specifically lines 5-8, of page 3 of the Response to Examiner's Final Action. Thus, the Examiner is incorrect with this assertion.

Most notable of the legal errors present in the examination of the Application is a failure of the Final Office Action of December 29, 2006 to establish a prima facie case of obviousness of the claims in the Application rejected under 35 U.S.C. §103(a). There has been no mention of the three criteria for a prima facie case of obviousness as spelled out in M.P.E.P. §2143. The Examiner has not cited any language from the prior art that would suggest that the Feldman, et al. patent can be combined in any manner with the Beveridge patent and the Kitazawa, et al. paper. The Examiner only provides a baseless subjective and conclusory "it would have been obvious" statement for combining the Beveridge patent, the Feldman, et al. patent, and the Kitazawa, et al. paper without providing any objective reasoning or citing any evidence of record to support such a position. The Examiner has not provided any reasons how the proposed combination of the Beveridge patent, the Feldman, et al. patent, and the Kitazawa, et al. paper would have any expectation of success let alone a reasonable expectation of success.

As for teaching the claimed invention, Independent Claim 1 recites ". . . transmitting light at a first wavelength carrying plain old telephone service telephonic signals from a

first plurality of telephone related devices and at a second wavelength carrying TV signals from a TV signal source through an optical fiber from a first end to a second end; receiving said first wavelength of light and generating first electrical signals within a first frequency band and representative of said plurality of plain old telephone service telephonic signals; receiving said second wavelength of light and generating second electrical signals within a second frequency band and representative of said TV signals; . . . transmitting light at said first wavelength and carrying said return plain old telephone service telephonic signals and said TV related information through said optical fiber from said second end to said first end . . .” The Examiner readily admits that the Beveridge patent fails to disclose these features and cites the Feldman, et al. patent in combination with the Beveridge patent to support the deficiencies thereof. As discussed above, the Feldman, et al. patent clearly recites a downstream wavelength of 1.5 μm and an upstream wavelength of 1.3 μm . Thus, the Feldman, et al. patent fails to disclose receiving first and second wavelengths of light as required by the claimed invention. Moreover, the Feldman, et al. patent fails to transmit light at the first wavelength that carries a return plain old telephone service telephonic signals with TV related information as provided by the claimed invention. The wavelengths used by the Feldman, et al. patent over its optical fiber are different for downstream and upstream transport. A wavelength used for downstream transport in the Feldman, et al. patent is not also used for upstream transport and vice versa. Therefore, Applicant respectfully submits that Claims 1-5 are patentably distinct from the proposed Beveridge - Feldman, et al. combination.

CONCLUSION

Applicant has now made an earnest attempt to place this Application in condition for allowance. For the foregoing reasons and for other apparent reasons, Applicant respectfully requests allowance of all pending claims.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.

Attorneys for Applicant

A handwritten signature in black ink, appearing to read 'Charles S. Fish', is written over the printed name.

Charles S. Fish

Reg. No. 35,870

April 28, 2006

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